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OFFICE OF PETITIONS

In re Application of :
Tim Dyer :
Application No. 09/836,426 :
Filed: April 17, 2001 : ON PETITION
Attorney Docket No.: :
35013.4000 :
:

This is a decision on three Petitions filed August 17, 2005. The first petition is to Withdraw the Holding of Abandonment of the application and is properly treated under 37 CFR 1.181. The second petition is for revival of an application abandoned unavoidably and is properly treated under 37 CFR 1.137(a). The third petition is for revival of an application abandoned unintentionally and is properly treated under 37 CFR 1.137(b).

The petition under 37 CFR 1.181 is dismissed as inappropriate.
The petition under 37 CFR 1.137(a) is dismissed.
The petition under 37 CFR 1.137(b) is granted.

Background:

The above-identified application became abandoned for failure to timely and properly reply to the final Office action, mailed July 15, 2003. The Office action set a three (3) month period for reply.

Applicant filed a response to the Office action in the form of a Notice of Appeal and an Amendment on October 20, 2003. In response, this Office mailed an Advisory Action on October 31, 2003, informing applicant that the Amendment would be entered, and that the period to file an appeal brief was as set forth in 37 CFR 1.192(a)¹.

¹ Now 37 CFR 41.37

No appeal brief having been filed, the appeal was dismissed, and the application became abandoned for failure to timely and properly reply to the final Office action, mailed July 15, 2003. A Notice of Abandonment was mailed June 16, 2005.

The instant petitions

Applicant files the instant petitions and argues that the abandonment should be withdrawn, or held to be unavoidable, or in the alternative unintentional because Applicant was awaiting a new, non-final Office action from the Examiner. Applicant avers that in December 2003 she discussed the case with the Examiner, that she thereafter followed up with several voice mail messages for the Examiner, and on June 14, 2004, the Examiner left a voice mail for Applicant, stating that the Examiner would issue a new, non-final Office action. Applicant provides that after receiving the voice mail message from the Examiner, she continued to follow-up with the Examiner by leaving a voice mail message, only to receive the Notice of Abandonment.

Petition to Withdraw Holding of Abandonment

The MPEP provides that

[a] petition to revive an abandoned application (discussed below) should not be confused with a petition from an examiner's holding of abandonment. Where an applicant contends that the application is not in fact abandoned (e.g., there is disagreement as to the sufficiency of the reply, or as to controlling dates), a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action, and such petition does not require a fee. Where there is no dispute as to whether an application is abandoned (e.g., the applicant's contentions merely involve the cause of abandonment), a petition under 37 CFR 1.137 (accompanied by the appropriate petition fee) is necessary to revive the abandoned application.

Here, Applicant does not argue as to the sufficiency of the reply, or as to controlling dates, but her contentions involve the cause of abandonment, i.e., that the Examiner said a new, non-final Office action would be forthcoming, and Applicant relied upon this assertion and awaited the new, non-final Office action. Accordingly, a petition to withdraw the holding of abandonment under 37 CFR 1.181 is inappropriate, and a petition under 37 CFR 1.137 is necessary to revive the application.

The Petition Under 37 CFR 1.137(a)

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (1) the required reply (unless previously filed), which may be met by the filing of a notice of appeal and the requisite fee; a Request for Continued Examination; an amendment or request for reconsideration which *prima facie* places the application in condition for allowance, or a first or second submission under 37 CFR 1.129(a) if the application has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 USC 120, 121 and 365(c); (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

Applicant lacks item (3) as set forth above.

Applicable Law

The general standard applied by the Office requires petitioner to establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.² 35 U.S.C. 41(c)(1) states, "The Commissioner may accept the payment of any maintenance fee ... at any time ... if the delay is shown to the satisfaction of the Commissioner to have been unavoidable." (emphasis added).

² The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

"In the specialized field of patent law, ... the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. His interpretation of those provisions is entitled to considerable deference." Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C.

1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg, 849 F.2d 1422, 1425, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute.")).

"The critical phrase 'unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable' has remained unchanged since first enacted in 1861." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982). The standard for "unavoidable" delay for reinstating a patent is the same as the unavoidable standard for reviving an application. See Ray v. Lehman, 55 F.3d 606, 608-609, 34 U.S.P.Q.2d (BNA) 1786, 1787 (Fed. Cir. 1995) (citing In re patent No. 4,409,763, 7 U.S.P.Q.2d (BNA) 1798, 1800 (Comm'r Pat. 1990); Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982)). The court in In re Mattullath, accepted the standard which had been proposed by Commissioner Hall which "requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business." In re Mattullath, 38 App. D.C. 497, 514-515 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)). However, "The question of whether an applicant's delay in prosecuting an application was unavoidable [will] be decided on a case-by-case basis, taking all of the facts and circumstances into account."³ Nonawareness of the content of, or a misunderstanding of, PTO statutes, PTO

³ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

rules, the MPEP, or Official Gazette notices, does not constitute unavoidable delay.⁴ The statute requires a "showing" by petitioner. Therefore, petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. It is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable.

Applicant is further advised that the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987). Specifically, petitioner's delay caused by the actions or inactions of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. 133 or 37 CFR 1.137(a). Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

Applicant's Assertion

Applicant files the instant petition and provides that the Examiner informed Applicant via a voice mail message that a new,

⁴ See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D. D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D. D.C. 1985) (Plaintiffs, through their counsel's actions, or their own, must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

non-final Office action would be forthcoming, and Applicant relied upon this assertion and awaited the new, non-final Office action, and took no further action in this case. Petition at p.2.

As to item (3), Applicant has failed to demonstrate that the delay in responding to the final Office action was unavoidable.

Regarding petitioner's argument, that the application became abandoned because Applicant relied upon the Examiner's statement that another Office action would be issued, and therefore Applicant took no further action in the case, Applicant is directed to 37 CFR 1.135(b), Abandonment For Failure to Reply Within Time Period, which reads:

Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

This section is further clarified in the MEPE, which provides

[f]or example, as 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, a delay is not "unavoidable" when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action.

This section explains that a delay is not unavoidable when the applicant is awaiting an action from the examiner. In other words, when Applicant filed the response to the final Office action, it was Applicants responsibility to file a complete and proper reply as the application required. The Advisory Action was a courtesy mailed to Applicant, which attempted to notify Applicant that the filed response failed to comply with what was required. The time to file a complete and proper reply

continued to run from the mailing of the Office action on July 15, 2003.

Finally, the MPEP cautions that

a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (A) the applicant's reliance upon oral advice from USPTO employees; or (B) the USPTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

Petition Under 37 CFR 1.137(b)

With the instant petition, Applicant has filed a Request for Continued Examination ("RCE") and a submission in the form of an Amendment.

Having found that all of the requirements for a grantable petition under 37 CFR 1.137(b) have been met, **this petition is hereby granted.**

The Petition fees, \$500 and \$1500, and the RCE filing fee, \$790.00, have been charged to deposit account 19-2814 as authorized in the instant petition(s).

This application is being returned to Technology Center 3723 for processing of the RCE and Amendment in due course.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3232.


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